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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,927	11/24/2003	Marvin P. Loeb	Loeb.M-03	6910

7590 07/21/2005

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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/721,927	LOEB, MARVIN P.	
	Examiner	Art Unit	
	Henry M. Johnson, III	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection. Gilbert is discussed below in U.S. Patent 4,240,202 for a knife with blade segments that are marked so that a dull, used portion may be removed to expose a new portion. The motivation for the blade removal is the same as that of the application, to restore usability to the operational member.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3 and 9, it is not clear how the fingers would grip the sleeve as required in claims 1 and 7 if the fingers are unable to close on the sleeve.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Walker et al. in view of U.S. Patent 4,240,202 to Gilbert. Walker et al. teach fiber optic

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cable assemblies for use in surgical and medical applications. A handle (Fig. 7A, # 76) is disclosed with a central bore and a stem (Fig. 7A, # 80) that is interpreted as a cannula. The channel is axially aligned with the stem (Col. 8, line 30) and is a larger diameter than the stem (Fig. 7A). The transition from channel to stem is interpreted as a shoulder. Walker et al. further discloses a fiber optic may be secured to the handle by a hex bolt with a compression fitting which would inherently prevent movement of the fiber relative to the handle. Optical fibers comprise a core covered by cladding, the cladding is interpreted as a sleeve. Walker et al do not teach the use of markers on the distal end of the fiber. Gilbert discloses a retractable knife blade which has "break-lines" for breaking off successive end portions (abstract). The "break-lines" are interpreted as markings at spaced intervals and are used to renew the operational portion of the instrument by discarding an old used portion, and exposing a new portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the "break-lines" as taught by Gilbert in the fiber of the invention of Walker et al. to provide a new fiber area as Gilbert clearly indicates a motivation to provide such capability.

Claims 2, 8, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Walker et al. in view of U.S. Patent 4,240,202 to Gilbert as applied to claims 1 and 7 above and further in view of U.S. Patent 5,417,684 to Jackson et al. Walker et al. and Gilbert are discussed above, but do not teach a compression nut with axial fingers or tapered threads. Jackson et al. disclose a surgical device that includes a fitting with fingers (Fig. 31, # 434) and tapered threads (Fig. 32, # 422). Compression fittings are well known in a plethora of arts and it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the compression fitting of Jackson et al. in the invention of Walker et al. in view of

Gilbert as one of many alternative compression fitting configurations. Likewise, the use of a compressible tube in such fittings is well known.

Claims 4, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Walker et al. in view of U.S. Patent 4,240,202 to Gilbert. Both are discussed above and Walker further discloses a bend distal end (Fig. 7A), but does not disclose using Nitinol[®] or other super-elastic material. Super-elastic materials are well known in the art (as disclosed by Giba et al. in U.S. Patent 6,126,654) and it would have obvious to one skilled in the art to use a super-elastic material if the device was used with a complimentary device that would alter its configuration and it was desired to have the device return to a predetermined shape.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Walker et al. in view of U.S. Patent 4,240,202 to Gilbert as applied to claims 1 and 7 above and further in view of U.S. Patent Application Publication US 2003/0078568 to Caldera et al. Walker et al. and Gilbert are discussed above, but do not disclose markings on a proximal end of a sleeve. Caldera et al. teach a medical laser device comprising an optical fiber having markings (Fig. 3a, # 45 & 46) which enable the optical fiber to be accurately positioned relative to an introducer sheath (abstract). Such markings are well known to provide positional information external to the device in use and, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the markings as taught by Caldera et al. in the invention of Walker et al. in view of Gilbert to provide visual feedback on the fiber position.

Allowable Subject Matter

Claims 13, 15 and 16 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

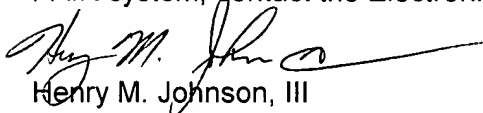
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry M. Johnson, III
Primary Examiner
Art Unit 3739